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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/479,997	06/07/1995	DEAN ENGELHARDT	ENZ-5(D6)(C2	8799
28171	7590	03/24/2005	EXAMINER	
ENZO BIOCHEM, INC. 527 MADISON AVENUE (9TH FLOOR) NEW YORK, NY 10022			MARSCHEL, ARDIN H	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

08/479,997

Applicant(s)

ENGELHARDT ET AL.

Examiner

Ardin Marschel

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 03 September 2004. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See parts (a) and (b) herein explained as attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 826-1227.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: of reasons of record which are explained further as attached.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

DETAILED ACTION

Further explanation of items # 3(a) and 3(b) on the enclosed Advisory action:

The amendments to the claims, proposed on 12/28/04, would raise new issues that would require further consideration and/or search due to seriously broadening the claims via the deletion of the Sig characteristics limitations, such as “non-polypeptide”, “non-nucleotidyl”, and “non-radioactive”. The resultant broader claim practice would require, in particular, consideration of a large body of prior art directed to radioactive Sig practice. Another new issue would be the reconsideration and re-institution of prior art rejections based on Dunn et al. [Cell 12:23 (1977)] and/or Hung (P/N 4,224,408) as indicated in the Final action, mailed 7/14/04, on page 6 therein based on subject matter that would be present in the instant claims, if entered. Such reconsiderations of prior art clearly would not place the application in better form for appeal by materially reducing or simplifying the issues for appeal, but rather would increase issues. Thus, the basis for non-entry of the amendment, proposed on 12/28/04, is well established.

Further explanation of item # 11 on the enclosed Advisory action:

The rejection of claims 826-1227 based on NEW MATTER via 35 USC 112, first paragraph, is maintained and reiterated from the previous office action, mailed 7/14/04. This rejection is maintained and reiterated due to the non-entry of the amendment as summarized above, however, it is noted that the amendment, proposed 12/28/04, contained amending that would have overcome this rejection, if it had been entered.

The rejection of claims 826-1227 based on vagueness and indefiniteness via 35 USC 112, second paragraph, is maintained and reiterated from the previous office action, mailed 7/14/04, regarding the issue of conflict between the independent claims citing deoxy-type oligomers vs. dependent claims requiring a ribonucleotide in the claimed composition. This rejection is maintained and reiterated due to the non-entry of

the amendment as summarized above, however, it is noted that the amendment, proposed 12/28/04, contained amending that would have overcome this rejection, if it had been entered.

The scope of enablement based rejection of claims 956-987 via 35 USC 112, first paragraph, is maintained and reiterated from the previous office action, mailed 7/14/04, regarding being enabled for the sugar being a furanose moiety, such as ribose or deoxyribose, but does not reasonably provide enablement for any generic sugar, such as recited in claim 956 etc. This rejection is maintained and reiterated due to the non-entry of the amendment as summarized above, however, it is noted that the amendment, proposed 12/28/04, contained amending that would have overcome this rejection, if it had been entered.

The 35 USC 102(a) prior art rejection based on Hartmann et al. [Biopolymers 20:2635 (1981)] is maintained and reiterated from the previous office action, mailed 7/14/04. This rejection would have maintained against appropriate instant claims even if the amendment, proposed on 12/28/04, had been entered because Sig moieties in the abstract of Hartmann et al. would still be reasonably chromogenic or fluorescent as cited in said abstract as contained within polymers as instantly claimed.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., Supervisory Patent Examiner, whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

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Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 17, 2005

 3/17/05
ARDIN H. MARSCHER
SUPERVISORY PATENT EXAMINER